

**REMARKS**

With this amendment, Applicants add claims 15-17 and modify claims 1 and 7.

Applicants submit that the modifications to claims 1 and 7 are for clarity and precision of language and do not change the scope of the pending claims.

Claims 1-17 are all the claims pending in the application.

**1. Claim Rejections Under 35 U.S.C. § 102**

The Examiner has rejected claims 1-5<sup>1</sup> under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. Sugaya ("Sugaya"). For at least the following reasons, Applicants traverse the rejection.

Claim 1 recites an "image outputting apparatus for printing an image on a recording sheet by using a storage medium in which a plurality of the images are recorded, said storage medium also storing additional information of the respective images." The Examiner contends that Sugaya discloses this feature. Specifically, the Examiner contends that external memory 317 corresponds to the claimed storage medium and that user names correspond to the claimed additional data. Office Action at page 2.

Sugaya discloses that external memory 317 is used for registering an exceptional character file or register data transferred from a form file. (Col. 11, lines 7-11.) There is no disclosure or suggestion that external memory 317 stores the user names, the alleged additional information. Sugaya, at most, may disclose the registration of user names is in RAM 306 (col.

---

<sup>1</sup> The Examiner confirmed on March 3, 2006, to Applicants' representative that only claims 1-5 should have been rejected under this section, not claims 6-14 as listed in the Office Action.

15, lines 55-56), which is separate storage device. Accordingly, even assuming, for the sake of argument alone, that external memory 317 corresponds to the claimed storage medium, Sugaya does not disclose or suggest the claimed storage of additional information in the claimed storage medium as set forth in claim 1.

In addition, Sugaya does not disclose or suggest that external memory 317 stores any images. Accordingly, Applicants submit that Sugaya does not support the Examiner's contention that external memory 317 corresponds to the claimed storage medium in which a plurality of images are recorded as set forth in claim 1.

To the extent the Examiner may now contend that RAM 306 corresponds to the claimed storage medium, Applicants submit that Sugaya, at most, may disclose that RAM 306 stores a single print job at a time (col. 10, line 59, to col. 11, line 1). Accordingly, there is no disclosure or suggestion that the laser printer 100 uses a storage medium in which a plurality of images are recorded along with their corresponding additional data as set forth in claim 1.

Applicants submit that claims 2-5 are patentable at least by virtue of their dependency.

In addition, claim 5 recites that the "displaying member is disposed on said sorting tray itself." The Examiner contends that this is merely a design choice and not a patentable feature. Applicants disagree.

Locating the display on the sorting tray itself readily identifies the classification of sorting tray to a user. In contrast, even assuming that display panel 102 would correspond to the claimed display, display panel 102 of Sugaya will require additional effort by the user to identify the classification of each tray since the user must first identify the classification on display 102 and then locate the tray that corresponds to the classification. Therefore, the claimed location

provides patentable advantages over other locations and would not be viewed as equivalent to other locations by those skilled in the art. Accordingly, Applicants submit that the claimed location is not merely a design choice and constitutes patentable subject matter.

Because Sugaya does not disclose or suggest disposing the display on the sorting tray itself as set forth in claim 5, Applicants submit that the rejection of claim 5 be withdrawn for this additional reason.

**2. Claim Rejections Under 35 U.S.C. § 103**

The Examiner has rejected claims 6-14 under 35 U.S.C. § 103(a) as being unpatentable over Sugaya and well known prior arts. For at least the following reasons, Applicants traverse the rejection.

Applicants submit that claims 6-14 are patentable at least by virtue of their dependency.

In addition, Applicants submit that use of Official Notice in the rejection of claims 6-14 is improper. The MPEP is clear in that Office Notice should not be used when asserting technical facts in areas of esoteric technologies. See MPEP §2144.03 at page 2100-142. Here, Applicants submit that digital cameras and the storage of data within a storage medium by the digital cameras would certainly qualify as esoteric technology.

Further, even if, for the sake of argument alone, the Examiner's contentions with respect to the subject matter of claims 6-14 are accurate, the Examiner's contentions would still not be relevant to the issues at hand.

For example, claim 6 recites that the "additional information is photographic information given at the time of taking said image." The Examiner contends that it is well known that

information such as time is encoded as additional information with the image. Office Action at page 4.

The Examiner's contention, even if accurate, is not relevant to the issue at hand. The issue, for now, is not whether storing additional photographic information at the time of taking an image may have been known. Rather, the issue is whether it would have been obvious to modify the system of Sugaya to use the "additional photographic information" instead of "user names" when assigning the virtual ejection ports.

Our case law is very clear in that mere "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). "[T]here must be some **motivation, suggestion or teaching of the desirability** of making the specific combination." *Id.* (emphasis added.) Here, the Examiner merely contends that the claimed feature is well known, but provides no explanation (let alone an explanation that is supported in the prior art) with respect to why one skilled in the art would have found it obvious or desirable to modify the system of Sugaya to substitute "user names" with "additional photographic information."

Moreover, when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Id.* at 1316-1317. Here, there is no suggestion or motivation to modify the specific teachings of Sugaya as claimed.

The Examiner's contentions in the rejection of claims 7-14 are similarly lacking in providing the necessary motivation, which is supported in the prior art, to modify the system of Sugaya as respectively set forth in claims 7-14.

Therefore, for at least the above reasons, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness for claims 6-14.

**3. New Claims**

With this amendment, Applicants add claims 15-17. Applicants submit that these claims are patentable at least by virtue of their dependency, as well as the features set forth therein.

**4. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: April 26, 2006

  
Bhaskar Kakarla  
Registration No. 54,627